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VEDDER PRICE P.C. 222 N. LASALLE STREET CHICAGO, IL 60601			EXAMINER YALEW, FIKREMARIAM A	
			ART UNIT 2436	PAPER NUMBER
			MAIL DATE 03/17/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/748,523

**Applicant(s)**

CHIVIENDACZ ET AL.

**Examiner**

FIKREMARIAM YALEW

**Art Unit**

2436

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-9, 11-23, 25-27 and 29-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-21 and 29-35 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-13, 22, 23, 25-27 and 36-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/03/2011
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The office action is in reply to an amendment filed on 01/03/2011. Claims 1, 6 have been amended. Claims 5,10,24,28 and 57 were canceled. Claims 1-4, 6-9, 11-23, 25-27, 29-56 are pending.

### Response to Arguments

2. The applicant argument regarding to the 35 U.S.C 101 rejections is not persuasive because claim 52 claims an apparatus claim without any structural component and consists solely of language that is implemented with only software therefore the examiner maintains the previous 35 U.S.C 101 rejection.

3. The examiner also thanks the applicant for understanding the typographical error and for the right assumption of rejection.

4. Applicant argument regarding to claims 14-21 and 29-35 rejection is persuasive and the examiner withdraws the rejection.

5. Applicant's arguments regarding to claims 1-4, 6-9, 11-13, 22-23 25-27 and 36-51 have been fully considered but they are not persuasive. Applicant argued that the prior art does not teach or suggest a first portion at least containing transaction card identification information ; a second portion containing a translucent identification member having a translucent area that includes one or more obscured user identifiers. The examiner disagree and points out the prior art teach a first portion at least containing transaction card identification information (See col. 1 lines 58-61 and claim 2 lines 45-47(i.e., **a frosted transparent plastic and the recording means comprises paper sheet member which is made from plastic & substrate which is a transparent plastic also includes sequence representing which are sequence of integers**)); a

second portion containing a translucent identification member having a translucent area that includes one or more obscured user identifiers (See col. 2 lines 45-47, col. 1 lines 45-61(i.e., **the substrate may be opaque and representing a predetermined sequence, predetermined sequence may be personal identification**)). The applicants argued that the combination of Goede and Ginter does not explicitly teach a translucent identification member that has identification information located at a different location for a plurality of obscured identifiers. Examiner disagrees and points out the combination of Goede and Ginter teach a different location for a plurality of obscured identifiers (See 0220 i.e., **identifying information may be embedded in an obscure & the information may specify that certain areas areas/or precise locations**). The applicant argued that the combination of Oksman and Goede teach sending a visual filtering pattern to a display device wherein the filtering pattern is defined such that when the visual filtering pattern is visually combined with one or more obscured user identifiers located on a translucent identification member. The examiner disagree and points out the combination of Goede and Oksman teach sending a visual filtering pattern to a display device wherein the filtering pattern is defined such that when the visual filtering pattern is visually combined with one or more obscured user identifiers located on a translucent identification member (See Oksman col. 4 lines 14-19, col. 4 lines 32-41, col. 5 lines 8-15(i.e., **characters or icons displayed on the display and visual filter**)).

#### **Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 52-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. Claim 52 is rejected under 35 USC 101 as not falling within one of the four statutory categorizes of invention. Claim 52 is an apparatus claim without any structural component and consists solely of language that is implemented with only software. Claim 52 does not provide any functional interrelationship to any software and hardware structural components to provide certain function that is processed by a computer. Claims 53-56 are depend on claim 52 and rejects on the same rational.

**Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-4, 22-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goede (US Patent No 5,246,375) in view of Ginter et al (hereinafter referred as Ginter) US Pub No 2005/017716 A1
11. As per claim 1: Goede discloses a method/apparatus for making a secure identification information member for a user comprising: generating a plurality of obscured user identifiers (See col. 3 lines 25-29); and generating a translucent identification member having a translucent area that includes the a plurality of obscured user identifiers (See col. 2 lines 45-47(i.e., the

substrate be transparent, frosted, colored or opaque)) the translucent identification member without corresponding filtering pattern thereon(See col. 1 lines 57-64(i.e., paper sheet member));assigning identification information to the a plurality of obscured user identifiers(See col. 1 lines 44-47(i.e., predetermined sequence such as personal identification number); storing the identification information and associated plurality of obscured user identifiers(See col. 1 lines 50-54(i.e., recoding the predetermined sequence); and providing the identification information on the translucent identification member(See col. 2 lines 45-47,col 1 lines 58-61(i.e., the substrate be transparent, frosted, colored or opaque).

Goede does not explicitly teach at a different location from the plurality of obscured identification.

However Ginter teaches at a different location from the plurality of obscured identification (See 0220).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Ginter with in Goede method in order to enhance security of the system.

12. As per claim 2: the combination of Goede and Ginter discloses the method wherein generating the one or more obscured user identifiers includes: obtaining user specific information associated with the user (See Goede col. 3 lines 57-62); and combining the user specific information with other information to produce the one or more obscured user identifiers (See Goede col. 1 lines 58-61, col. 2 lines 45-47).

13. As per claim 3: the combination of Goede and Ginter discloses the method wherein generating the one or more obscured user identifiers includes: obtaining user specific information

associated with the user (See Goede col. 1 lines 44-47); and using the user specific information to produce the one or more obscured user identifiers (See Goede col. 2 lines 50-61).

14. As per claim 4: the combination of Goede and Ginter discloses the method of wherein generating the one or more obscured user identifier includes: generating the one or more obscured user identifiers using the assigned identification information. (See Goede col. 1 lines 58-61, col. 2 lines 45-47).

15. As per claim 22: Goede disclose a method for associating secure identification information with a user comprising: receiving a request from a user for one or more obscured user identifiers (See col. 3 lines 25-29 ); recording a link between the user and the identification information associated with the one or more obscured user identifiers(See col. 1 lines 47-56); and wherein the one or more obscured user identifiers are on a translucent identification member, sized to be smaller than a display, that is sent to the user(See col. 2 lines 45-47,col 1 lines 58-61 and Fig 4a).

However Goede does not explicitly teach wherein the request from the user includes user specific information and wherein the user specific information is combined with other information to produce the one or more obscured user identifiers.

Ginter teaches wherein the request from the user includes user specific information and wherein the user specific information is combined with other information to produce the one or more obscured user identifiers (See 0220).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Ginter with in Goede method in order to enhance security of the system.

16. As per claim 23: the combination of Goede and Ginter discloses the method including: providing the one or more obscured user identifiers to the user (See Goede col. 1 lines 44-47).

17. As per claim 25: the combination of Goede and Ginter discloses the method including: providing the one or more obscured user identifiers to the user are sent to third party to be placed on a translucent identification member for the user (See Goede col. 3 lines 11-29).

18. As per claim 26: the combination of Goede and Ginter discloses the method wherein the one or more obscured user identifiers are sent to the user for placement on a translucent identification member (See Goede col. 3 lines 11-29).

19. As per claim 27: the combination of Goede and Ginter discloses the method wherein the one or more obscured user identifiers are selected from a pre-existing pool of obscured user identifiers (See Goede col. 2 lines 54-67).

**20. Claims 11-13, 20 and 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oksman et al (hereinafter referred as Oksman) US Patent No 5,233,436 in view of Goede (US Patent No 5,246,375).**

21. As per claim 11: Oksman discloses a method for securely providing identification information comprising: sending a visual filtering pattern to a display device wherein the filtering pattern is defined such that when the visual filtering pattern is visually combined with one or more obscured user identifiers located on a translucent identification member (See col. 4 lines 14-19,col 4 lines 32-41,col 5 lines 8-15), a designated one of the one or more identifiers is visually revealed (col. 3 lines 62-65,col 4 lines 17-19); and receiving data representing the visually revealed identifier(col. 5 lines 5-15).



Oksman does not explicitly teach obscured user identifiers located on a translucent identification member and identification member sized to be smaller than a display.

However Goede obscured user identifiers located on a translucent identification member(See col. 2 lines 45-47,col 1 lines 58-61); identification member sized to be smaller than a display(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksman in order to enhance security of the system.

22. As per claim 12: the combination of Oksman and Goede disclose the method including sending the received data representing the visually revealed identifier to an authentication apparatus (See Oksman col. 5 lines 5-15).

23. As per claim 13: the combination of Oksman and Goede discloses the method wherein the data representing the visually revealed identifier is received using a device other than the device on which the visual filtering pattern is displayed (See Oksman col. 3 lines 63-65 and col. 4 lines 14-18).

24. As per claim 36: Oksman discloses an apparatus for securely providing identification information comprising : a translucent identification member authenticator, comprising one or more processors, operative to receive user data representing a revealed identifier in response to overlaying a translucent identification member on a display (See Oksman col. 4 lines 14-41,col 5 lines 8-15); and operative to compare the received data with a corresponding expected revealed identifier to determine whether proper authentication of the user is appropriate (see Oksman col. 5 lines 5-15).

Oksman does not explicitly teach a translucent identification member with obscured user identifiers thereon; sized to be smaller than a display that is sent to the user.

However Goede teaches a translucent identification member with obscured user identifiers thereon (See col. 2 lines 45-47,col. 1 lines 58-61);sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksman in order to enhance security of the system

25. As per claim 37: Oksman and Goede disclose the apparatus wherein the translucent identification member authenticator determines the expected revealed identifier prior to the receipt of the received data corresponding to the revealed identifier (See Oksman col. 5 lines 5-15).
26. As per claim 38: Oksman and Goede disclose the apparatus wherein the translucent identification member authenticator determines the expected revealed identifier after the receipt of the received data corresponding to the revealed identifier (See Oksman col. 5 lines 5-15).
27. As per claim 39: Oksman discloses an apparatus for associating secure identification information with a user comprising: a circuit operative to receive a request from a user for a translucent identification member (See Oksman col. 4 lines 14-41 col.5 lines 27-36, col. 5 lines 43-48); and operative to record a link between the user and the identification information associated with the one or more obscured user identifiers (See Oksman col. 6 lines 6-12).

Oksman does not explicitly teach translucent identification member; sized to be smaller than a display, that is sent to the user.

However Goede teaches translucent identification member(See col. 2 lines 45-47,col 1 lines 58-61); sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksman in order to enhance security of the system.

28. As per claim 40: Oksman and Goede disclose the apparatus wherein the circuit is operative to select the one or more obscured user identifiers are selected from a pre-existing pool of one or more obscured user identifiers (See Oksman col. 6 lines 6-12).

29. As per claims 41-42: Oksman and Goede teach the circuit is operative to request information from the user that includes user specific information and wherein the user specific information is combined with other information to produce the one or more obscured user identifiers(See col. 2 lines 45-47,col 1 lines 58-61).

30. As per claim 43: Oksman discloses an apparatus for securely providing identification information comprising: a visual filtering pattern generator operative to generate a visual filtering pattern based on data identifying a translucent identification member that has a translucent area that includes one or more obscured user identifiers such that when the visual filtering pattern is visually combined with the one or more obscured user identifiers on the translucent identification member (col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15), a designated one of the one or more obscured user identifiers is revealed(col. 4 lines 14-19,col 4 lines 32-41).

Oksman does not explicitly teach translucent identification member; sized to be smaller than a display, that is sent to the user.

However Goede teach translucent identification member (See col. 2 lines 45-47, col. 1 lines 58-61): sized to be smaller than a display, that is sent to the user (See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksman in order to enhance security of the system

31. As per claim 45: Oksman discloses a method for securely providing identification information comprising: displaying a visual filtering pattern defined such that when the visual filtering pattern is combined with one or more obscured user identifiers located on a translucent identification member, a designated one of the one or more visual identifiers is revealed (col. 4 lines 14-18,col 4 lines 16-25); and receiving input data representing the visually revealed identifier (col. 4 lines 14-18,col 5 lines 5-15).

Oksman does not explicitly teach translucent identification member sized to be smaller than a display that is sent to the user.

However Goede teaches translucent identification member (See col. 2 lines 45-47,col 1 lines 58-61)sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksman in order to enhance security of the system.

32. As per claim 46: Oksman and Goede disclose the method wherein displaying the visual filtering pattern includes indicating an overlay area on the display for overlaying the translucent identification member (See Oksman col. 4 lines 16-25).

33. As per claim 47: Oksman and Goede disclose the method including the step of transmitting the received input data representing the visually revealed identifier (See Oksman col. 4 lines 16-25).
34. As per claim 48: Oksman and Goede disclose the method wherein the received input data is received on a device other than the device that is used to display the visual filtering pattern (See Oksman col. 5 lines 8-15).
35. As per claim 49: Oksman and Goede disclose a secure identification information member comprising: a translucent area having an information pattern representing one or more identifiers configured to overlay a portion of a display screen (See Oksman col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).
36. As per claim 50: Oksman and Goede disclose the secure identification information member including additional information thereon relating to at least one specific use of the member (See Oksman col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).
37. As per claim 51: Oksman and Goede disclose the secure identification information member wherein the additional information represents information for use in at least one of: voting, banking, online transaction and membership (See Oksman col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).

### **Claim Rejections - 35 USC § 102**

38. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

39. Claims 6-9 and 52-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Goede et al (hereinafter referred as Goede, US Patent No 5,246,375).

40. As per claim 6: Goede discloses an apparatus for creating an apparatus for securely providing identification information comprising: one or more processors operative to generate one or more obscured user identifiers(See col. 3 lines 25-29)); and a translucent identification member former in communication with the one or more processors operative to generate a translucent identification member having a translucent area that includes the one or more obscured user identifiers the translucent identification member without a corresponding filtering pattern thereon(See col. 1 lines 57-64); and wherein the one or more processors is operative to assign identification information to the one or more obscured user identifiers, store the identification information and associated one or more obscured user identifiers(See col. 1 lines 44-47(i.e., predetermined sequence such as personal identification number)); and provide the identification information and associated one or more obscured user identifiers, and provide the identification information for placement on the translucent identification member(See col. 2 lines 45-47,col 1 lines 58-61).

41. As per claim 7: Goede teaches the apparatus wherein the one or more processors is operative to obtain user specific information associated with user; and combine the user specific information with other information to produce the one or more obscured user identifiers(See col. 1 lines 44-47).

42. As per claim 8: Goede teaches the apparatus wherein the one or more processors is operative to obtain user specific information associated with a user and use the user specific information to produce the one or more obscured user identifiers(See col. 3 lines 25-29).

43. As per claim 9: Goede teaches the apparatus wherein the one or more processors is operative to generate the one or more obscured user identifiers using the assigned ID information(See col. 3 lines 25-29).

44. As per claim 52: Goede discloses a transaction card comprising: a first portion at least containing transaction card account information (See col. 2 lines 45-47,col 1 lines 58-61 ); a second portion containing a translucent identification member having a translucent area that includes one or more obscured user identifiers(See col. 2 lines 45-47,col 1 lines 58-61).

45. As per claim 53: Goede disclose the transaction card wherein the second portion containing the translucent identification member includes an attached translucent identification member (See col. 1 lines 57-64).

46. As per claim 54: Goede disclose the transaction card wherein the second portion containing the translucent identification member includes an open area with a connecting structure configured to receive and hold the translucent identification member (See col. 1 lines 57-64 and Fig 5).

47. As per claim 55: Goede disclose the transaction card wherein the translucent identification member is configured to overlay at least a portion of a display screen (See col. 1 lines 57-64 and Fig 5).

48. As per claim 56: Goede disclose the transaction card wherein the translucent identification member includes a translucent area having an information pattern representing a

plurality of different identifiers for use at a plurality of different times and is configured to overlay at least a portion of a display screen (See col. 1 lines 57-64 and Fig 5).

#### **Allowable Subject Matter**

49. Claims 14-21 and 29-35 are allowed. If the other independent claims re-write including the all future of independent claims 14 & 19 then the other independent claims will be allowable

#### **Conclusion**

**50. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fikremariam Yalew/  
Examiner, Art Unit 2436  
03/12/2010

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